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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,664	01/13/2006	Stefan Bachstein	4091.012	1697
37999 7590 04/29/2009 24IP LAW GROUP USA, PLLC 12 E. LAKE DRIVE ANNAPOLIS, MD 21403				
EXAMINER				
MCLELLAND, KIMBERLY KEIL				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
04/29/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/564,664

**Applicant(s)**

BACHSTEIN, STEFAN

**Examiner**

KIMBERLY K. MCCLELLAND

**Art Unit**

1791

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01/28/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, and 31-32 is/are pending in the application.
- 4a) Of the above claim(s) 10-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 31-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 5-9 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4-9 have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0126597 to Cohen et al. as applied to claims 1-4 and 32 above, and further in view of U.S. Patent No. 7,063,768 to Tsujimoto et al.

4. With respect to claim 1, Cohen et al. discloses a laminate manufacturing process, including providing at least one continuous process foil (20) depositing a continuous, substantially non-polymeric semi-manufactured product band (16) to the process foil (20) sealing the semi-manufactured product band (16) with respect to the process foils (20) by gluing (18) said semi-manufactured product band to said process foils (20); depositing a hardenable synthetics (14) to the semi-manufactured product

band (16); while providing a bonding between the synthetics and the semi-manufactured product (see Figure 1A). However, Cohen et al. does not specifically disclose hardening the synthetics.

5. Tsujimoto et al. discloses a method of making laminates, including it is known in the art as equivalent to provide polymer layers as either a separate film, or by coating to form the layer (column 22, lines 44-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the equivalent unhardened synthetic coating layer followed by a hardening step to form the laminate as taught by Tsujimoto et al. for the synthetics in hardened film form disclosed by Cohen et al.

6. As to claim 2, Cohen et al. discloses the step of depositing a continuous process foil (12) on the hardenable synthetics (see Figure 1A).

7. As to claim 3, Cohen et al. discloses the step of introducing reinforcement material into the hardenable synthetics (15).

8. As to claim 4, Cohen et al. does not specifically disclose the step of calendaring by means of a calendar. Examiner notes the phrase "especially preferably immediately prior to the hardening step" does not further limit to the claim.

9. Tsujimoto et al. discloses a method of making laminates, including calendaring (4; See Figure 2). It would have been obvious to one of ordinary skill in the art to calendar the laminate of Cohen et al. as taught by Tsujimoto et al. The motivation would have been to provide a smooth surface on the laminate.

10. As to claim 31, Cohen et al. discloses dispensing gluing tape (18) as an intermediate later between the semi-manufactured product band and the process foil (See Figure 1A).
11. As to claim 32, Cohen et al. does not specifically disclose depositing fluid glue between the semi-manufactured product band and the process foil.
12. Tsujimoto et al. discloses a method of making laminates, including it is known in the art as equivalent to provide polymer layers as either a separate film, or by coating to form the layer (column 22, lines 44-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the equivalent fluid polymer layer as taught by Tsujimoto et al. for the polymer in hardened film form disclosed by Cohen et al.

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 1-9 and 31-32 have been considered but are moot in view of the new ground(s) of rejection. Applicant's remaining pertinent arguments are addressed below:
14. The words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). As applicant has not set forth any new, limiting definition of a "process foil" in the current specification, any film or web used in a process is considered as meeting the limitation of a "process foil". An applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim

terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Consequently, applicant's argument that the prior art does not specifically disclose the exact term "process foils" is not persuasive.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **KIMBERLY K. MCCLELLAND** whose telephone number

is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly K McClelland/  
Examiner, Art Unit 1791

KKM

/Philip C Tucker/  
Supervisory Patent Examiner, Art Unit 1791